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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,787	05/04/1999	CARL J. EVENS	COS-98-009	1151
25537	7590	03/10/2006	EXAMINER	
MCI, INC 1133 19TH STREET NW 4TH FLOOR WASHINGTON, DC 20036			SOBUTKA, PHILIP	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/304,787

Applicant(s)

EVENS ET AL.

Examiner

Philip J. Sobutka

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 51 is rejected under 35 U.S.C. 102(b) as being anticipated by DeLuca et al (US 5,870,030).

Consider claim 51. DeLuca teaches a method for providing a paging service, the method comprising:

receiving an advertisement script from a third party (*Deluca shows the advertising source as item 100 in figures 5,6,and 7, and describes them in column 7, lines 43-50*);

determining which one or more paging units is to receive the advertisement script based on a criteria (*Deluca teaches the service determining which pager is to receive the ads in column 7, line 43- column 8, line 39*);

transmitting the advertisement script to the one paging unit (*Deluca teaches the transmitting the ads in column 7, line 43- column 8, line 39*); and

crediting an account associated with the one paging unit (*Deluca describes the crediting arrangement in column 6, line 65 – column 7, lines 42*).

3. Claims 29-31, 33-38, 41-45, 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandy et al (US 6,625,464).

Consider claim 29. Bandy teaches a method of messaging, comprising:

generating an advertisement (*Bandy teaches that the message can be used for advertising in column 2, lines 45-47, column 9, lines 6-47, column 11, lines 40-49, and especially column 12, lines 26-34*), capcode that is separate from a programmed capcode of a paging unit (*Bandy teaches that the receivers can have several separate capcodes in column 3, lines 8-50*),

wherein the advertisement capcode is selectively assigned to the paging unit (*Bandy teaches selectively assigning the group message capcodes to the units for example in column 8, lines 32-54*); and

designating an advertisement script for transmission to the paging unit if the paging unit has been assigned the advertisement code (*Bandy teaches transmitting the advertisement to the receiver based on the assigned capcode in column 12, lines 26-34*).

As to claim 30, Bandy teaches the method according to claim 29, further comprising:

storing the advertisement capcode in a central database (*Bandy discloses storing the capcode in a central database in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*);

programming the paging unit with the advertisement capcode (*Bandy teaches programming the receivers in column 4, lines 15-30, and column 8, lines 32-54*);;

correlating the advertisement capcode stored in the central database with the programmed capcode into the paging unit (*Bandy teaches correlating the capcodes in column 5, lines 25-45*); and

transmitting the advertisement script to the paging unit based upon the correlation (*Bandy teaches transmitting the advertisement to the receiver based on the assigned capcode in column 12, lines 26-34*).

As to claim 31, Bandy teaches a method according to claim 29, further comprising:

transmitting a message along with the advertisement script to the paging unit (*Bandy teaches transmitting the advertisement to the receiver based on the assigned capcode in column 12, lines 26-34*).

As to claim 33, Bandy teaches a method according to claim 29, wherein the advertisement capcode is assigned to a plurality of paging units including the paging unit (*Bandy see column 3, lines 47-50*).

As to claim 34, Bandy teaches a method according to claim 29, further comprising: un-assigning the advertisement capcode from the paging unit (*Bandy see column 7, line 65 – column 8, line 57, column 9, lines 10-40*).

As 35, Bandy teaches a method according to claim 29, wherein the advertisement capcode is assigned based on a marketing criteria (*Note that the claim does not specify that the system determines the marketing criteria, therefore since Bandy's sponsors decide to purchase advertising or not it is of course based on marketing criteria, see for example column 9, lines 25-50*).

As to claim 36, Bandy teaches a method according to claim 29, further comprising: receiving the advertisement script from an entity different from a provider of service for the paging unit (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*).

Consider claim 37. Bandy teaches a method for communicating within a paging network, the method comprising:

storing, in memory, an advertisement capcode for receiving an advertisement script (*Bandy teaches storing the codes in the receivers in column 4, lines 15-30, and column 8, lines 32-54*), wherein

the advertisement capcode is separate from a programmed capcode designated for receiving messages (*Bandy teaches that the receivers can have several separate capcodes in column 3, lines 8-50*),

the advertisement script being retrieved based on the advertisement capcode (*Bandy teaches that the receivers retrieve the messages based on the capcodes for example in column 4, lines 55-65, and column 12, lines 25-34*).

As to claim 38, Bandy teaches a method according to claim 37, wherein the advertisement capcode is maintained in a central database by a service provider (*Bandy discloses storing the capcode in a central database in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*),

the advertisement capcode being correlated with the programmed capcode (*Bandy teaches correlating the capcodes in column 5, lines 25-45*).

As to claim 41, Bandy teaches a method according to claim 37, further comprising: removing the advertisement capcode from the memory (*Bandy see column 7, line 65 – column 8, line 57, column 9, lines 10-40*).

As to claim 42, Bandy teaches a method according to claim 37, wherein the advertisement capcode is assigned based on a marketing criteria including characteristics of a subscriber corresponding to the programmed capcode (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*).

As to claim 43, Bandy teaches a method according to claim 37, wherein the advertisement script is created by an entity different from a provider of the paging network (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*).

Consider claim 44. Bandy teaches an apparatus of communicating within a paging network, the apparatus comprising:

a memory configured to store an advertisement capcode for receiving an advertisement script (*Bandy teaches a memory for storing the codes in the receivers in column 4, lines 15-30, and column 8, lines 32-54*),,

wherein the advertisement capcode is separate from a programmed capcode designated for receiving messages,

the advertisement script being retrieved based on the advertisement capcode.

As to claim 45, bandy teaches the apparatus according to claim 44, wherein the advertisement capcode is maintained in a central database by a service provider (*Bandy discloses storing the capcode in a central database in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*), and

the advertisement capcode being correlated with the programmed capcode. (*Bandy teaches correlating the capcodes in column 5, lines 25-45*).

As to claim 48, Bandy teaches an apparatus according to claim 44, wherein the advertisement capcode is removed from the memory (*Bandy see column 7, line 65 – column 8, line 57, column 9, lines 10-40*).

As to claim 49, Bandy teaches an apparatus according to claim 44, wherein the advertisement capcode is assigned based on a marketing criteria including characteristics of a subscriber corresponding to the programmed capcode (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*)..

As to claim 50, Bandy teaches an apparatus according to claim 44, wherein the advertisement script is created by an entity different from a provider of the paging

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network (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*).

Claim Rejections - 35 USC § 103

4. Claims 32,39,40,46,47,51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandy in view of DeLuca et al (US 5,870,030).

As to claim 32, Bandy as applied to claim 29 above, lacks a teaching of crediting a subscriber account associated with the paging unit based on usage of the advertisement capcode.

DeLuca teaches a method of transmitting advertising to pagers in which a pager account is credited for the advertising page (*DeLuca describes the crediting arrangement in column 6, line 65 – column 7, lines 42*). DeLuca teaches that this ensures that the ad is read, while defraying the cost of pager use (*DeLuca see especially column 1, lines 33-52, column 7, lines 43 – column 8, lines 40*). It would have been obvious to one of ordinary skill in the art to modify Bandy to credit the user account in order to defray the cost of use as well as ensuring that the ads are actually viewed, as taught by DeLuca.

As to claim 39, Bandy as applied to claim 37 above lacks a teaching of receiving the advertisement script with a message, wherein the advertisement script precedes the message.

DeLuca teaches a paging system which transmitting ads prior to a message in order to ensure that the subscriber views the ad rather than viewing the message and ignoring the ad (*DeLuca column 1, lines 35-38*). It would have been obvious to one of ordinary skill in the art to modify Bandy to transmit the ads prior to a message in order to ensure that the subscriber views the ad as taught by DeLuca.

As to claim 40, Bandy as applied to claim 37 lacks a teaching of a credit being earned by a subscriber of the paging network if the advertisement capcode is utilized.

Deluca teaches a method of transmitting advertising to pagers in which a pager account is credited for the advertising page (*Deluca describes the crediting arrangement in column 6, line 65 – column 7, lines 42*). Deluca teaches that this ensures that the ad is read, while defraying the cost of pager use (*Deluca see especially column 1, lines 33-52, column 7, lines 43 – column 8, lines 40*). It would have been obvious to one of ordinary skill in the art to modify Bandy to credit the user account in order to defray the cost of use as well as ensuring that the ads are actually viewed, as taught by DeLuca.

As to claim 46, Bandy as applied to claim 44 above lacks a teaching of receiving the advertisement script with a message, wherein the advertisement script precedes the message.

DeLuca teaches a paging system which transmitting ads prior to a message in order to ensure that the subscriber views the ad rather than viewing the message and

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ignoring the ad (*DeLuca column 1, lines 35-38*). It would have been obvious to one of ordinary skill in the art to modify Bandy to transmit the ads prior to a message in order to ensure that the subscriber views the ad as taught by DeLuca.

As to claim 47, Bandy as applied to claim 44 lacks a teaching of a credit being earned by a subscriber of the paging network if the advertisement capcode is utilized.

Deluca teaches a method of transmitting advertising to pagers in which a pager account is credited for the advertising page (*Deluca describes the crediting arrangement in column 6, line 65 – column 7, lines 42*). Deluca teaches that this ensures that the ad is read, while defraying the cost of pager use (*Deluca see especially column 1, lines 33-52, column 7, lines 43 – column 8, lines 40*). It would have been obvious to one of ordinary skill in the art to modify Bandy to credit the user account in order to defray the cost of use as well as ensuring that the ads are actually viewed, as taught by DeLuca.

Consider claim 51. Bandy teaches a method for providing a paging service, the method comprising:

receiving an advertisement script from a third party (*Note that Bandy's ads come from information suppliers not the paging service as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*).;

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determining which one or more paging units is to receive the advertisement script based on a criteria (*Bandy teaches correlating the capcodes to determine reception in column 5, lines 25-45*);

transmitting the advertisement script to the one paging unit (*Bandy teaches transmitting the advertisement to the receiver based on the assigned capcode in column 12, lines 26-34*).

Bandy lacks a teaching of crediting an account associated with the one paging unit.

Deluca teaches a method of transmitting advertising to pagers in which a pager account is credited (*Deluca describes the crediting arrangement in column 6, line 65 – column 7, lines 42*). Deluca teaches that this ensures that the ad is read, while defraying the cost of pager use (*Deluca see especially column 1, lines 33-52, column 7, lines 43 – column 8, lines 40*). It would have been obvious to one of ordinary skill in the art to modify Bandy to credit the user account in order to defray the cost of use as well as ensuring that the ads are actually viewed, as taught by DeLuca.

As to claim 52, note that Bandy in view of Deluca teaches the method according to claim 51, wherein the one paging unit is programmed with a plurality of capcodes, wherein one of the capcodes is designated for use to receive the advertisement script (*Bandy teaches that the receivers can have several separate capcodes in column 3, lines 8-50, and that the receivers retrieve the messages based on the capcodes for example in column 4, lines 55-65, and column 12, lines 25-34*).

5. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandy in view of DeLuca and in view of Dimitriadis et al (US 5,664,948).

Consider claim 53. Bandy in view of DeLuca as applied to claim 51 lack a teaching of the ad being replayed by the pager as a voice signal.

Dimitriadis teaches replaying advertisement pages as voice signals (*Dimitriadis see especially column 2, line 62 – column 3, line 9*). It would have been obvious to one of ordinary skill in the art to modify Bandy in view of DeLuca to replay the ads as voice signals in order to eliminate the need for the user to read them, thereby increasing the likelihood that the user would take in the ad.

Consider claim 54. Bandy in view of DeLuca as applied to claim 51 lack a teaching of the advertisement script includes wording of an advertisement and a date and time of when to broadcast the advertisement.

Regarding the ad wording, note that Bandy's suppliers would presumably supply the ad copy (*Note that Bandy's ads come from information suppliers and would presumably include the wording, as shown in figure 2, and column 5, lines 25-45, column 9, lines 7-47, and column 12, lines 25-34*), however Bandy lacks a teaching of the wording being included. Official Notice is taken that it is well known to have advertisers supply ad copy. It would have been obvious to one of ordinary skill in the art to modify Bandy to have the advertisers supply the wording in order to ensure that the ad contained the exact message the advertiser wished to convey.

Bandy also lacks a teaching of the advertisement script includes a date and time of when to broadcast the advertisement.

Dimitriadis notes that advertisers desire to specify the exact time when their message will be broadcast (*Dimitriadis see especially column 1, lines 25-40*). Therefore it would have been obvious to one of ordinary skill in the art to further modify Bandy to have the ad contain the time and date of broadcast in order to allow advertisers to specify the exact timing of their ads.

6. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeLuca in view of Bandy et al (US 6,625,464).

As to claim 52, DeLuca as applied to claim 51 above, lacks a teaching of the receivers being programmed with multiple capcodes, the capcodes being used to receive the ads.

Bandy teaches a paging unit programmed with a plurality of capcodes, wherein one of the capcodes is designated for use to receive the advertisement script (*Bandy teaches that the receivers can have several separate capcodes in column 3, lines 8-50, and that the receivers retrieve the messages based on the capcodes for example in column 4, lines 55-65, and column 12, lines 25-34*).

It would have been obvious to one of ordinary skill in the art to modify DeLuca to use the capcodes of Bandy in order to utilize conventional paging protocols.

7. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLuca and in view of Dimitriadis et al (US 5,664,948).

Consider claim 53. DeLuca as applied to claim 51 lacks a teaching of the ad being replayed by the pager as a voice signal.

Dimitriadis teaches replaying advertisement pages as voice signals (*Dimitriadis see especially column 2, line 62 – column 3, line 9*). It would have been obvious to one of ordinary skill in the art to modify DeLuca to replay the ads as voice signals in order to eliminate the need for the user to read them, thereby increasing the likelihood that the user would take in the ad.

Consider claim 54. DeLuca as applied to claim 51 lacks a teaching of the advertisement script includes wording of an advertisement and a date and time of when to broadcast the advertisement.

Regarding the ad wording, note that DeLuca's suppliers would presumably supply the ad copy (*DeLuca shows the advertising source as item 100 in figures 5,6, and 7, and describes them in column 7, lines 43-50*), however DeLuca lacks a teaching of the wording being included. Official Notice is taken that it is well known to have advertisers supply ad copy. It would have been obvious to one of ordinary skill in the art to modify DeLuca to have the advertisers supply the wording in order to ensure that the ad contained the exact message the advertiser wished to convey.

DeLuca also lacks a teaching of the advertisement script includes a date and time of when to broadcast the advertisement.

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Dimitriadis notes that advertisers desire to specify the exact time when their message will be broadcast (*Dimitriadis see especially column 1, lines 25-40*). Therefore it would have been obvious to one of ordinary skill in the art to further modify DeLuca to have the ad contain the time and date of broadcast in order to allow advertisers to specify the exact timing of their ads.

Response to Arguments

8. Applicant's arguments with respect to claims 29-54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached Monday through Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177.

10. The central fax phone number for the Office is 571-273-8300.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Handwritten signature of Philip J. Sobutka in cursive script, followed by the date 3/6/6.

PHILIP J. SOBUTKA
PATENT EXAMINER

Philip J Sobutka

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